

REMARKS

By this Amendment, Applicant has amended claims 1, 5, 8-12, 15, 17, and 18, and added new claims 21-37, such that claims 1-37 are pending in this application.

In the outstanding Office Action, the Examiner rejected claims 1, 3, 10, 12, 18, and 19 under 35 U.S.C. § 101; rejected claims 18-19 under 35 U.S.C. § 112, second paragraph; rejected claims 1-4, 9, 12-14, and 17 under 35 U.S.C. § 102(e) as being anticipated by Kurzius et al. (U.S. Patent No. 6,385,620); rejected claims 5-8, 15, 16, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Kurzius et al. in view of Kenyon (U.S. Patent No. 6,370,542); and rejected claims 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Kurzius et al. in view of Nadkarni (US. Patent No. 6,266, 659). Applicant respectfully traverses these rejections.¹

I. Rejections Under 35 U.S.C. § 101

With regard to the rejection under 35 U.S.C. § 101, the Examiner asserts that claims 1, 3, 10, 12, 18, and 19 are directed to non-statutory subject matter. In particular, the Examiner asserts that independent claims 1, 10, and 12 “only recite an abstract idea” and do not “involve, use, or advance the technological arts (i.e., computer, processor, electronically, etc.), since the steps could be performed using pencil and paper.” (O.A. at 2-3.) As to independent claim 18, the Examiner alleges that

¹ Applicant submits that the remarks made in this Amendment are sufficient to overcome the Examiner’s rejections. Accordingly, any silence by Applicant to the assertions made by the Examiner in rejecting the claims is not a concession by Applicant that those assertions were proper or correct. Further, the Office Action contains a number of statements characterizing the related art and the claims. Regardless of whether this Amendment identifies any such statements, Applicant declines to automatically subscribe to those statements in the Office Action.

the claim is not patentable because it recites “only functional and nonfunctional descriptive material.” (O.A. at 3.)

Although Applicant disagrees with the Examiner’s position, Applicant has amended claims 1, 10, 12, and 18 to recite that certain elements are performed “electronically.” Accordingly, Applicant respectfully requests the Examiner to withdraw the rejections of claims 1, 3, 10, 12, 18, and 19 under 35 U.S.C. § 101.

II. Rejection Under 35 U.S.C. § 112

In rejecting claims 18-19 under 35 U.S.C. § 112, second paragraph, the Examiner alleges that the claims do not “clearly indicate whether Applicant is claiming software per se, the associated hardware, or a combination of both.” (O.A. at 4.) Applicant respectfully disagrees. Nevertheless, to expedite prosecution, Applicant has amended claim 18 to clarify that the claim is directed to a user interface. Applicant thus submits that claims 18 and 19 fully meet the requirements of 35 U.S.C § 112, second paragraph and, therefore, requests that the Examiner withdraw this rejection.

III. Rejections Under 35 U.S.C. §§ 102 and 103

Applicant respectfully traverses the rejection of claims 1-4, 9, 12-14, and 17 under 35 U.S.C. § 102(e) as being anticipated by Kurzius et al.

Independent claims 1, 9, 12, and 17 are patentably distinguishable from Kurzius et al. For example, claim 1 relates to a computer-implemented method for ordering workers for a client. The method includes receiving an order request processed in a number of stages. Claim 1 further recites “displaying a summary of action taken on the order request during each processing stage.” Claims 9, 12, and 17, although of different scope, recite similar elements.

With regard to the rejection under 35 U.S.C. § 102(e), the Examiner correctly admits that Kurzius et al. fails to teach the limitation of “displaying a summary of action taken on the order request during each processing stage, wherein the first display screen displays, for each processing stage, text of an electronic mail sent to the client.” (O.A. at 9 (“Kurzius et al. does not explicitly disclose generating a display screen providing a summary of action taken on the order request during each processing stage....”).) Accordingly, on this basis, the rejection of claims 1, 9, 12, and 17 under § 102(e) should be withdrawn.

Applicant notes, however, that the Examiner cites Kenyon for a purported disclosure of a display screen. In particular, the Examiner rejected claims 5-8, 15, 16, and 18-20 under 35 U.S.C. § 103(a) as being unpatentable over Kurzius et al. in view of Kenyon. Applicant respectfully traverses this rejection and submits that Kenyon fails to cure the above defects of Kurzius et al.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. M.P.E.P. § 2143.03. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. *Id.* at § 2143.01. Third, a reasonable expectation of success must exist that the proposed modification will work for the intended purpose. *Id.* at § 2143.02. Moreover, each of these requirements must “be found in the prior art, and not be based on

applicant's disclosure." *Id.* at § 2143. Here, the Examiner has failed to comply with all three requirements.

First, Kenyon discloses a system for "recording an organizing knowledge assets acquired during the design, testing, and use of a product or technology." (Col. 1, lines 42-45.) The Examiner relies upon a status/implementation window 34 which shows where a knowledge object is within the process for knowledge acquisition and management. (Col. 8, line 66 - col. 9, line 10.) Kenyon further discloses that "[t]he status display sorts and displays objects based on their status (e.g. 'created,' 'initiated,' etc.)." *Id.* The Examiner has failed to show, however, that Kenyon describes window 34 as "providing a summary of action taken on the order request during each processing stage," as recited in independent claims 1, 9, 12, and 17. Indeed, nothing in the portions of Kenyon relied upon by the Examiner (e.g., col. 9, lines 1-10 and 37-53) disclose or suggest that window 34 provides a summary of action taken on a knowledge object.

Second, the Examiner has provided absolutely no proper motivation to combine Kurzius et al. with Kenyon in the first place. Kurzius et al. relates to a system for automated candidate recruiting. (Abstract.) Kenyon, in contrast, relates to a database for "organizing knowledge assets acquired during the design, testing, and use of a product or technology." (Col. 1, lines 42-45.) In an apparent recognition that both references concern entirely different technical fields, the Examiner resorts to the vague and overly general statement that both references are "concerned with efficient acquisition, storage, and dissemination of information." (O.A. at 8.) Applicant submits that such a general statement is not a proper motivation and, therefore, the Examiner

has failed to establish a *prima facie* case of obviousness. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (determinations of *prima facie* obviousness, including motivation, must be supported by a finding of “substantial evidence”).

Third, there is no evidence of a reasonable expectation of success that would prompt a person of ordinary skill in the art to combine Kurzius et al. and Kenyon. In this regard, the Examiner alleges that the use of the status/implementation window 34 of Kenyon would provide “an efficient manner of tracking the status of the job posting process.” (O.A. at 8.) This allegation is not properly supported, however, and does not show that a skilled artisan would have combined the references as alleged.

Furthermore, claims 6-8, 16, 18, 20, and 37 recite additional features not taught or suggested by the cited references. Claim 6, for example, recites a combination including “wherein the status display components correspond to a series of bars equal to the number of stages” and “highlighting the number of bars corresponding to the current stage.” Beyond citing to the conventional “scroll bars” used in Kurzius et al. — which have nothing to do with the status display components as claimed — the Examiner admits that Kurzius et al. and Kenyon are both silent as to these limitations. (O.A. at 8.) In an attempt to compensate for this shortcoming, the Examiner appears to take Official Notice that such processes are obvious as they would provide “an efficient means of quickly determining the status of the job posting process.” (O.A. at 9.)

Applicant traverses the Examiner’s taking of Official Notice. An Official Notice rejection is improper unless the facts asserted are well-known or common knowledge in the art, and capable of instant and unquestionable demonstration as being well-known. See M.P.E.P. § 2144.03; *Dickinson v. Zurko*, 527 U.S. 150 (1999); *In re Ahlert*, 424

F.2d, 1088, 1091. Further, any facts asserted as well-known should serve only to “fill in the gaps” in an insubstantial manner. It is never appropriate to rely solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based. Id. Applicant submits that the recitations recited in claim 6 are not unquestionably well-known, and that the Examiner has failed to demonstrate to the contrary. Accordingly, Applicant traverses the Official Notice and requests that the Examiner either cite a competent prior art reference in substantiation of his conclusions, or else withdraw the rejection. Claims 16, 18, 20, and 37, although of different scope, recite similar elements.

Other dependent claims recite additional subject matter that is totally remote from the teachings of either Kurzius et al. or Kenyon. For example, claim 7 recites “generating a second display screen including a listing of order requests” and “associating with each order request listed in the second display screen the corresponding status display component.” The Examiner alleges that Kurzius et al. teaches these features by disclosing “the employer database and job posting are updated to reflect the addition of a new posting 1306, figure 13” and “[determining] which step of the process the job posting is currently at, figure 13.” Applicant submits that these alleged teachings of Kurzius et al. are inadequate to teach the elements of claim 7. Indeed, the Examiner has not even cited to a portion of Kurzius et al. that purportedly supports the rejection. Claim 20, although of different scope, recites similar elements.

Further, claim 8 recites “wherein the displaying further comprises displaying, for each processing stage, text of an electronic mail sent to a user associated with the

order request.” Kurzius et al. and Kenyon alone or in combination fail to teach or disclose these limitations. Indeed, the Examiner never addressed this feature. For this additional reason, Applicant submits that claim 8 is allowable over the cited references. Again, claim 20, although of different scope, recites similar elements.

For the above reasons, Applicant submits that claims 1, 9, 12, 17, 18, 20, and 37 are allowable. Claims 2-8, 13-16, 19, 21-24 and 31-36 are also allowable over Kurzius et al. and Kenyon at least due to their dependence from one of claims 1, 9, 12, and 17. Accordingly, Applicant respectfully submits that the Examiner should withdraw the rejections under §§ 102 and 103.

Finally, with respect to the rejection of claims 10-11 under 35 U.S.C. § 103(a) as being unpatentable over Kurzius et al. and Nadkarni, Applicant submits that claims 10-11, although of different scope, recite elements similar to those discussed above with regard to claims 1, 9, 12, and 17. Accordingly, for the reasons given above, Applicant submits that claims 10-11 are allowable over Kurzius et al. Furthermore, Nadkarni does not make up for the deficiencies of Kurzius et al. Indeed, the Examiner applies only Nadkarni for its alleged teaching of an “employer search restricted to groups of vendors...” (O.A. at 13-14.) Accordingly, Applicant submits that claims 10-11 are allowable over the cited references and that the rejection under § 103(a) should be withdrawn. Claims 25-30 are also allowable over Kurzius et al. and Kenyon at least due to their dependence from one of claims 10-11.

VI. Conclusion

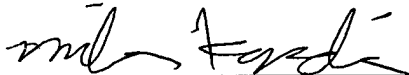
In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims 1-37.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 7, 2005

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